REMARKS

In the Office Action, the Examiner rejected claims 1 and 19 under 35 U.S.C. § 112, first paragraph; rejected claims 1, 3, 5-7, 9-13, 15-19, 21-23, 26-30, 32, 33, 126, and 127 under 35 U.S.C. § 112, second paragraph; rejected claims 1, 3, 5-7, 9-13, 17-19, 21-23, 26-30, 126 and 127 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,144,745 to Akiyama et al. ("*Akiyama*"), U.S. Patent No. 6,792,411 to Massey ("*Massey*"), and U.S. Patent No. 5,794,207 to Walker et al. ("*Walker*"); and rejected claims 15, 16, 32, and 33 under 35 U.S.C. § 103(a) as being unpatentable over *Akiyama*, *Massey*, and *Walker* in view of U.S. Patent No. 6,834,348 to Tagawa et al. ("*Tagawa*").

By this amendment, Applicants amend claims 1, 12, and 19. Support for these amendments can be found, for example, at ¶¶ [0080] and [0099] of Applicants' Patent Application Publication No. 2002/0165811. Claims 1, 3, 5-7, 9-13, 15-19, 21-23, 26-30, 32, 33, 126, and 127 are pending.

Applicants respectfully traverse the rejection of claims 1 and 19 under 35 U.S.C. § 112, first paragraph for failing to comply with the enablement requirement. The phrase highlighted by the Examiner is disclosed, for example, at ¶¶ [0067], [0083], [0102], and [0116], and also Figure 20 (S757, S760) of Applicants' Patent Application Publication No. 2002/0165811. Accordingly, claims 1 and 19 are enabled by the specification as required by 35 U.S.C. § 112, first paragraph.

Applicants respectfully traverse the rejection of claims 1, 3, 5-7, 9-13, 15-19, 21-23, 26-30, 32, 33, 126, and 127 under 35 U.S.C. § 112, second paragraph as failing to particularly point out and distinctly claim the invention. The Examiner alleges that the

phrase "storing investment target data," as recited in claim 19, is unclear as far as "where the data is transmitted from and how the data is transmitted." *Office Action*, page 4. However, as stated by the MPEP:

> Breadth of a claim is not to be equated with indefiniteness. *In re Miller*, 441 F.2d 689, 169 USPQ 597 (CCPA 1971). If the scope of the subject matter embraced by the claims is clear, and if applicants have not otherwise indicated that they intend the invention to be of a scope different from that defined in the claims, then the claims comply with 35 U.S.C. 112, second paragraph. MPEP § 2173.04 (emphasis added).

Accordingly, the pending claims particular point out and distinctly claim the invention as required by 35 U.S.C. § 112, second paragraph.

Applicants respectfully traverse the rejection of claims 1, 3, 5-7, 9-13, 17-19, 21-23, 26-30, 126 and 127 under 35 U.S.C. § 103(a) as being unpatentable over *Akiyama*, *Massey*, and *Walker* because a *prima facie* case of obviousness has not been established.

Independent claim 1 recites an investment system including a server device for "receiving a second request to sell a second investment ticket to a third investor," and "setting the price of the second investment ticket according to a performance of the investment target." *Akiyama*, *Massey*, and *Walker* fail to teach or suggest the claimed "server device for . . . setting the price," as claimed.

Akiyama discloses a system for ensuring that data is not illegally copied. *Akiyama*, col. 1, lines 29-31. However, *Akiyama* is silent with respect to the claimed "server device."

Massey discloses Web server 200 for providing a user with a storyboard synopsis of an uncompleted movie. *Massey*, col. 2, lines 37-40. After viewing the

storyboard, the user may access Web server 200 to purchase stock from the production company that corresponds to the uncompleted movie. *Id.* at lines 46-48. When the movie is completed, the user is entitled to a free copy of the movie as a dividend of the purchased stock. *Id.* at lines 49-51.

Massey's Web server 200 does not constitute or suggest the claimed "server device" at least because it does not "set[] the price of the second investment ticket according to a performance of the investment target," as recited in claim 1 (emphasis added). Instead, *Massey's* stock in the production company is sold in connection with an uncompleted movie. *Massey*, col. 2, lines 46-48. Because the movie is uncompleted, "a performance of" the movie cannot be used to set the price of *Massey's* production company stock.

Walker fails to cure the deficiencies of *Akiyama* and *Massey* by also failing to teach or suggest the claimed "server device for . . . setting the price," as recited in claim 1.

Accordingly, *Akiyama*, *Massey*, and *Walker* fail to teach or suggest claim 1, and do not establish a *prima facie* case of obviousness with respect to this claim. Independent claim 19, while of different scope than claim 1, distinguishes over *Akiyama*, *Massey*, and *Walker* for similar reasons as claim 1. Claims 3, 5-7, 9-13, 17, 18, 21-23, 26-30, 126 and 127 depend from one of claims 1 or 19.

Applicants respectfully traverse the rejection of claims 15, 16, 32 and 33 under 35 U.S.C. § 103(a) as being unpatentable over *Akiyama*, *Massey*, *Walker*, and *Tagawa*.

Claims 15, 16, 32 and 33 depend from one of independent claims 1 or 19, and therefore, include all recitations therein. As discussed previously, *Akiyama*, *Massey*, and *Walker* fail to teach or suggest claims 1 and 19.

Tagawa fails to cure the deficiencies of *Akiyama*, *Massey*, and *Walker*. *Tagawa* fails to teach or suggest a "server device for . . . setting the price," as recited in claim 1. Accordingly, *Akiyama*, *Massey*, *Walker*, and *Tagawa* fail to teach or suggest claims 15, 16, 32 and 33.

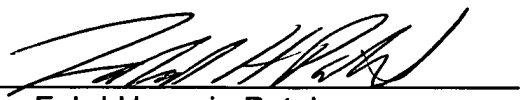
In view of the foregoing, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: January 15, 2009

By: 

Fahd Hussein Patel
Reg. No. 61,780
(202) 408-6072